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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/808,492	03/14/2001	Shigcho Ogawa	450100-03064	3619

20999 7590 01/04/2007  
FROMMER LAWRENCE & HAUG  
745 FIFTH AVENUE- 10TH FL.  
NEW YORK, NY 10151

EXAMINER
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SON, LINH L D

ART UNIT	PAPER NUMBER
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2135

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/04/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

09/808,492

Applicant(s)

OGAWA ET AL.

Examiner

Linh LD Son

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 September 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This Office Action is responding to the Appeal received on 09/29/06.
2. Claims 1-17 are pending.
3. Reopening of Prosecution - New Ground of Rejection After Appeal or Examiner's Rebuttal of Reply Brief In view of the Appeal Brief filed on 09/29/06, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below. To avoid abandonment of the application, appellant must exercise one of the following two options: (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or, (2) request reinstatement of the appeal. If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, and 3-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over deCarmo, US Patent No. 6760915B2 (Cited in US PTO 892 dated 07/27/05), in view of Wood et al, US Publication No. 2002/0057893A1, hereinafter "Wood".

6. As per claims 1 and 4-6:

deCarmo discloses "An information playback apparatus for playing back a recording medium on which image information is recorded" in (Col 3 lines 25-30), "comprising: first fetching means for fetching identification information, input by a user, used for identification of a recording medium" in (Col 5 lines 20-25, and Col 8 lines 10-30); "second fetching means for fetching a permission condition, input by the user, for permitting playback of the image information recorded on a recording medium" in (Col 7 lines 43-50, and Col 8 lines 57-67); "storage means for storing the identification information fetched by said first fetching means and the permission condition fetched by said second fetching means" in (Col 3 lines 25-30); "extraction means for extracting the identification information recorded on a recording medium loaded in said information playback apparatus" in (Col 6 lines 38-45, and Col 8 lines 34-55); "first comparison means for comparing the identification information extracted by said extraction means and the identification information stored in said storage means with each other" in (Col 9 lines 55-65, Col 5 lines 20-25, and Col 8 lines 34-55); "third fetching means for fetching a permission condition when the identification information extracted by said extraction

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means and the identification information stored in said storage means coincide with each other" in (Col 10 lines 50-65); "second comparison means for comparing the permission condition fetched by said third fetching means and the permission condition stored in said storage means with each other; and control means for controlling playback of the image information recorded on the recording medium in response to a result of the comparison by said second comparison means" in (Col 8 lines 34-56), "wherein said user is able to increase a value of said identification information input by a user (Col 4 lines 49-64, and Col 8 lines 10-30 and lines 60-67 (multiple registration of video stream sources), used for identification of a recording medium and a value of said identification information recorded on a recording medium loaded in said information playback apparatus" in (Col 4 lines 49-64, Col 5 lines 20-25, and Col 8 lines 10-30 and lines 60-67).

However, deCarmo does not disclose "wherein the increased values of the identification information are written over the original values of the identification information in the storage means, and wherein, if a maximum of identification information is achieved, new identification information is written over an oldest identification information or the new identification information is written over a user-selected replaceable identification information."

Nevertheless, Wood discloses a "Digital Recording and Playback" invention, which discloses a method of recording movies, TV shows, and other contents in a digital VCR by using a specified record stack size for personal favorite recording queue. The queue has number of contents to be recorder. If the maximum number has reached, the oldest

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show will be recorded with the oldest show, which discloses the "wherein the increased values of the identification information are written over the original values of the identification information in the storage means, and wherein, if a maximum of identification information is achieved, new identification information is written over an oldest identification information or the new identification information is written over a user-selected replaceable identification information." (Paragraph 0102).

Therefore, it would have been obvious at the time of the invention was made for one having ordinary skill in the art to modify deCarmo invention to incorporate Wood's teaching of adding contents into a queue for recording, wherein if the maximum number content has reached in the queue, the newest content will be written over the oldest content according to the predetermined stack size.

7. As per claim 3:

deCarmo discloses "An information playback apparatus according to claim 1, wherein the permission condition includes a parental level" in (Col 3 lines 25-30).

8. As per claim 7:

deCarmo discloses "The information playback apparatus according to claim 6, wherein the permission condition derived from said recording medium is afforded a higher weighting than the viewing permission information" in (Col 3 lines 25-30).

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9. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over deCarmo in view Wood and further in view of Lewis et al, US Patent No. 6385388B1, hereinafter "Lewis" (Cited in US PTO 892 dated 07/27/05).

10. As per claims 2:

deCarmo and Wood discloses "An information playback apparatus according to claims 1". However, deCarmo and Wood do not teach "the permission condition includes a password". Nevertheless, Lewis does teach this feature in (Col 7 lines 7-20).

Therefore, it would have been obvious at the time of the invention for one having ordinary skill in the art to incorporate Lewis's feature in deCarmo and Wood's invention to further protect the disc being tampered with.

11. Claims 8-11, and 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lewis in view of Wood et al, US Patent No. 5621456, hereinafter "Wood".

12. As per claims 8 and 13:

Lewis discloses "A method for controlling playback of a recording medium comprising: establishing a permission condition associated with a playback device, as a function of first input by a user" in (Col 2 lines 53-65); "storing the permission condition; establishing a recording medium identification for each of one or more recording media, as a function of second input by the user" in (Col 3 lines 23-27, Col 3 lines 30-44, Col 4 lines 12-20, line 25, Col 5 lines 20-35); "storing the recording medium identification for

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each of the one or more recording media; and comparing the stored permission condition and the stored recording medium identification for a particular recording medium, wherein when the permission condition satisfies a predetermined relationship with the recording medium identification, a valid password, input by a user, is required to initiate playback of the particular recording medium" in Col 6 line 63 to Col 7 line 20), "wherein said user is able to increase a value of said permission condition associated with said playback device and a value of said recording medium identification for each of said one or more recording media" in (Col 3 lines 12-40, and (Col 5 line 53-67). However, Lewis does not disclose "wherein the increased values of the identification information are written over the original values of the identification information in the storage means, and wherein, if a maximum of identification information is achieved, new identification information is written over an oldest identification information or the new identification information is written over a user-selected replaceable identification information."

Nevertheless, Wood discloses a "Digital Recording and Playback" invention, which discloses a method of recording movies, TV shows, and other contents in a digital VCR by using a specified record stack size for personal favorite recording queue. The queue has number of contents to be recorder. If the maximum number has reached, the oldest show will be recorded with the oldest show, which discloses the "wherein the increased values of the identification information are written over the original values of the identification information in the storage means, and wherein, if a maximum of identification information is achieved, new identification information is written over an



oldest identification information or the new identification information is written over a user-selected replaceable identification information.” (Paragraph 0102).

Therefore, it would have been obvious at the time of the invention was made for one having ordinary skill in the art to modify deCarmo invention to incorporate Wood's teaching of adding contents into a queue for recording, wherein if the maximum number content has reached in the queue, the newest content will be written over the oldest content according to the predetermined stack size.

13. As per claims 9, and 14:

Lewis discloses “An information playback apparatus according to claims 8, and 14, wherein the permission condition includes a password” in (Col 7 lines 7-20).

14. As per claims 10, and 15:

Lewis discloses “An information playback apparatus according to claims 8, and 15, wherein the permission condition includes a parental level” in (Col 5 lines 60-67).

15. As per claims 11 and 16:

Lewis discloses “The method according to claims 8 and 13 further comprising: determining an eject condition; and requiring the user to provide the valid password to initiate playback of the particular recording medium following the eject condition” in (Col 7 lines 38-49).

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16. Claims 12, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lewis in view of Wood and further in view of Mages et al, US Patent No. 6035329, hereinafter "Mages" (Cited in US PTO 892 dated 07/27/05).

17. As per claims 12 and 17:

Lewis and Wood discloses "The method according to claims 8 and 17 further comprising storing a parental level for each of the one or more recording media" in (Col 5 lines 30-35). However, Lewis and Wood does not teach of storing the password for each of the one or more recording media. Nevertheless, Mages discloses the "Method of Securing the Playback of a DVD-ROM Via Triggering Data Sent Via a Cable Network" invention, which includes a teaching of encoding the password in the media for playing protection in (Col 4 lines 5-20). Therefore, it would have been obvious at the time of the invention for one having ordinary skill in the art to incorporate Mages's feature with Lewis and Wood's invention to further add a second layer of playback protection on the media.

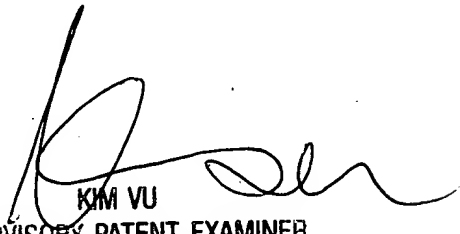
18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Linh LD Son whose telephone number is 571-272-3856. The examiner can normally be reached on 9-6 (M-F).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Linh LD Son  
Examiner  
Art Unit 2135



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